

## REMARKS

### I. PRELIMINARY REMARKS

Claims 1-3, 7, 9-11, 14, 15, 17 and 20-24 have been amended.<sup>1</sup> Claims 13, 16, 18, 19, 27 and 28 have been canceled. No claims have been added. Claims 1-12, 14, 15, 17 and 20-26 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes with appreciation that the Office Action indicated that claims 16 and 17 are directed to patentable subject matter. As claim 15 has been rewritten so as to include the combination of elements previously recited in now-canceled claim 16, and claim 17 has been rewritten in independent form, applicant respectfully submits that claims 15, 17, 25 and 26 are in condition for allowance.

### II. PRIOR ART REJECTIONS

#### A. The Rejections

Claims 1, 2, 4, 6-10, 12-15, 18-21, 23, 25 and 27 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 3,950,580 to Boudet ("the Boudet patent"). Claims 3, 11, 22, 24, 26 and 28 have been rejected under 35 U.S.C. § 103 as being unpatentable over the Boudet patent.

As claims 13, 18, 19, 27 and 28 have been canceled, and claim 15 now recites the combination of elements previously recited in claim 16, application respectfully submits that the rejections of claims 13, 15, 18, 19 and 25-28 have been rendered moot. The rejections of the remaining claims under 35 U.S.C. §§ 102 and 103 are respectfully

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<sup>1</sup> Claim 14 has merely been rewritten in independent form.

traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

### **B. The Cited Reference**

The Boudet patent is directed to device for displaying address labels on a letter or parcel. The device includes a **transparent** sheet 1, through which an address label may be viewed, and adhesive 2 along the edges of the transparent sheet. The adhesive 2 along three of the edges is covered by film strips (not shown), while the adhesive material along one of the edges is divided into a pair of adhesive strips and is covered by a pair of film strips 4 and 5. Because the adhesive along one of the edges is divided into a pair of adhesive strips and covered by a pair of film strips, the device may be used twice, as is discussed in column 1, lines 47-68.

### **C. Discussion Concerning Claims 1-12 and 20-22**

Independent claims 1, 7, 9 and 20 call for respective combinations of elements including, *inter alia*, "an **at least substantially opaque sheet.**" The respective combinations defined by claims 2-6 and 8 include, *inter alia*, the elements recited in claim 1, the combinations defined by claims 21 and 22 include, *inter alia*, the elements recited in claim 7, and the combinations defined by claims 10-12 include, *inter alia*, the elements recited in claim 9.

With respect to the rejection under 35 U.S.C. § 102, the Boudet patent fails to teach or suggest each and every element of the respective combinations recited in independent claims 1, 7, 9 and 20. For example, sheet 1 in the Boudet device is **transparent**, not an at least substantially opaque. The rejection of claims 1, 2, 4, 6-10, 12, 20 and 21 under 35 U.S.C. § 102 should, therefore, be withdrawn.

Turning to the rejection under 35 U.S.C. § 103, applicant respectfully submits that one of ordinary skill in the art would not have been motivated to modify the Boudet device such that sheet 1 was at least substantially opaque. The Boudet sheet 1 is used

to form a see-through pocket for a mailing label. If sheet 1 was at least substantially opaque, the user's ability so see the mailing label through the sheet would be severely compromised or completely eliminated. As noted in MPEP § 2143.01, modifications that would render a prior art device unsatisfactory for its intended purpose simply are not obvious. Claims 3, 5, 11 and 22 are, therefore, patentable for at least the same reasons as independent claims 1, 7 and 9, and the rejection of claims 3, 5, 11 and 22 under 35 U.S.C. § 103 should also be withdrawn.

#### D. Discussion Concerning Claims 14, 23 and 24

Independent claim 14 calls for a combination of elements including, *inter alia*, "a sheet defining ... first and second intersecting side edges ... one of longitudinal ends of each of the first and second side edges defining a common longitudinal end," "**a plurality of first strips of adhesive material ... adjacent to the *first side edge*,**" "**a plurality of second strips of adhesive material ... adjacent to the *second side edge*,**" "**a plurality of first liners** respectively positioned over the plurality of ***first strips*** of adhesive material" and "**a plurality of second liners** respectively positioned over the plurality of ***second strips*** of adhesive material." The respective combinations defined by claims 23 and 24 include, *inter alia*, the elements recited in claim 14.

With respect to the rejection under 35 U.S.C. § 102, the Boudet patent fails to teach or suggest each and every element of the combination recited in independent claim 14. For example, only one side of the Boudet device includes more than one adhesive strip and a corresponding plurality of liners. The rejection of claims 14 and 23 under 35 U.S.C. § 102 should, therefore, be withdrawn.

Turning to the rejection under 35 U.S.C. § 103, applicant respectfully submits that one of ordinary skill in the art would not have been motivated to modify the Boudet device such that more than one of the sheet sides included a plurality of adhesive strips and a corresponding plurality of liners. The Boudet send and re-send process discussed in column 1, lines 47-68 **only requires one side** of sheet 1 to include a plurality of adhesive strips and a corresponding plurality of liners. Claim 24 is, therefore,

patentable for at least the same reasons as independent claim 14 and the rejection of claim 24 under 35 U.S.C. § 103 should also be withdrawn.

### III. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

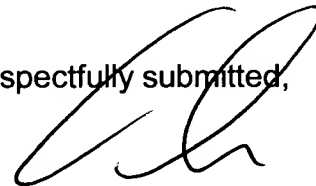
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

1/4/06  
Date

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Respectfully submitted,



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